

REMARKS

Claims 1-23 and 39-41 are pending in this application. By this Amendment, claims 24-38, 42 and 43 are withdrawn and claims 1, 8 and 15 are amended. Support for the amendments to claims 1, 8 and 15 can be found at least in claims 39 and 41 and page 11, lines 27-28 and Figs. 1-4. Thus, no new matter is added.

Entry of the amendments is proper under 37 C.F.R. §1.116 since the amendments: (a) place the application in condition for allowance (for the reasons discussed herein); (b) do not raise any new issue requiring further search and/or consideration (since the amendments amplify issues previously discussed throughout prosecution); (c) satisfy a requirement of form asserted in the previous Office Action; (d) do not present any additional claims without canceling a corresponding number of finally rejected claims; and (e) place the application in better form for appeal, should an appeal be necessary. The amendments are necessary and were not earlier presented because they are made in response to arguments raised in the Final Rejection. Entry of the amendments is thus respectfully requested.

Applicant appreciates the courtesies shown to Applicant's representatives by Examiner Poon in the April 27, 2005, personal interview and in the May 5, 2005, telephone interview. Applicant's separate record of the substance of the interview is incorporated into the following remarks.

Reconsideration based on the following remarks is respectfully requested.

I. Restriction Requirement

The Office Action deems the Restriction Requirement final. By this Amendment, non-elected claims 24-38, 42 and 43 are withdrawn.

II. Drawings Satisfy 37 C.F.R. §1.83(a)

The Office Action objects to the drawings under 37 C.F.R. §1.83(a) as not showing "the copy start step and the copy start device." This objection is respectfully traversed.

Support for the copy start step and the copy start device can be found in the specification at least on page 11, lines 27-28. The copy start device is the control panel 4 of the MFC1 or the PC50. The copy start step is when the PC copy is designated by the operator. See, e.g., pg. 11, lines 27-28. The copy start step is also shown in Fig. 6.

Thus, the drawings satisfy 37 C.F.R. §1.83(a). Withdrawal of the objection is respectfully requested.

III. Claims 39-41 Satisfy 35 U.S.C. §112, First Paragraph

The Office Action rejects claims 39-41 under 35 U.S.C. §112, first paragraph as allegedly failing to comply with the written description requirement. This rejection is respectfully traversed.

As discussed above, the copy start device is the control panel 4 of the MFC1 or PC50. The copy start step is when the PC copy is designated by the operator. See, e.g., pg. 11, lines 27-28. Support for these features can also be found in the specification at least at page 14, line 25-page 15, line 7. See also Figs. 4, 6, 7 and 8.

Thus, claims 39-41 satisfy 35 U.S.C. §112, first paragraph. Withdrawal of the rejection is respectfully requested.

IV. The Claims Define Patentable Subject Matter

A. Claims 1, 2, 5, 8, 9, 12, 15, 16, 19, 20 and 39-41

The Office Action rejects claims 1, 2, 5, 8, 9, 12, 15, 16, 19, 20 and 39-41 under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 5,781,310 to Nakamura in view of U.S. Patent No. 5,469,533 to Dennis. This rejection is respectfully traversed.

None of the applied references teach or suggest a copying system "wherein the peripheral device and the printing device are incorporated into one body," as recited in amended independent claim 1. Similarly, none of the applied references teach or suggest a

method of copying operating a copying system that includes "the peripheral device and the printing device being incorporated into one body," as recited in amended independent claim 15. Further, none of the applied references teach or suggest a copy system "including a host device having, in one body, a large-capacity storage device and a peripheral device connected to the host device," as recited in amended independent claim 8.

Further, there would have been no motivation to combine Nakamura with Dennis to achieve these features. If a proposed modification or combination that would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1994); see also MPEP §2143.01. The advantage of the copying system of Nakamura is to provide an image copying system that provides an image inputting unit and an image outputting unit separate from each other. See, e.g., Nakamura, col. 2, lines 45-54. That is, the copying system of Nakamura has an advantage in that a copy system can be handled as the copy machine is separated into small units. See e.g., Nakamura, col. 2, lines 13-14. The advantage is in the manufacturing of the copying machine of Nakamura, because each unit of the copying machine can be manufactured at a different site (factory) and design changes can be made on a per-unit basis. See e.g., Nakamura, col. 2, lines 18-22. Because the intended purpose of the copy system of Nakamura is to be separated into small units for easier handling and manufacturing, there would have been no motivation to combine Nakamura and Dennis to achieve the features recited in the independent claims. In fact, Nakamura teaches away from such combinations or modifications.

None of the applied references teach or suggest a copying system "wherein when a copying is started, the reading by the reading device, the conversion by the converting device, the transmission by the first transmission device, the reception and the storing by the reception control device, the transmission by the second transmission device and the

reception and the printing by the reception printing device are performed successively based on the start of copying," as recited in amended independent claim 1 and as similarly recited in amended independent claim 8. Similarly, none of the applied references teach or suggest a method of copying operating a copy system "wherein when a copying is started, the reading step, the conversion step, the first transmission step, the reception control step, the storing step, the second transmission step and the reception printing step are performed successively based on the start of copying," as recited in amended independent claim 15.

In the electronic filing system for Nakamura, the image data stored in the memory unit 6 is transferred to the image outputting unit 2 so as to print the image data only when an outputting operation for the image data is requested. See, e.g., Nakamura, col. 14, lines 1-15. Thus, the electronic filing system of Nakamura does not successively perform each process based on the start of copying. Further, nowhere does Dennis teach or suggest this feature.

Thus, independent claims 1, 8, 15 and the claims dependent therefrom, would not have been rendered obvious by Nakamura in view of Dennis. Accordingly, withdrawal and reconsideration of the rejection is respectfully requested.

B. Claims 3, 4, 10, 11, 17, 18 and 21

The Office Action rejects claims 3, 4, 10, 11, 17, 18 and 21 under 35 U.S.C. §103(a) as allegedly being unpatentable over Nakamura in view of Dennis and further in view of U.S. Patent No. 5,717,843 to Tabata. This rejection is respectfully traversed.

Tabata would not remedy the deficiencies of Nakamura and Dennis discussed with regard to claims 1, 8 and 15. Claims 3 and 4 depend from claim 1, claims 10 and 11 depend from claim 8, and claims 17, 18 and 21 depend from claim 15. Thus, for at least the reasons discussed above with regard to independent claims 1, 8 and 15, claims 3, 4, 10, 11, 17, 18 and 21 would not have been rendered obvious by Nakamura in view of Dennis and further in view

of Tabata. Accordingly, withdrawal and reconsideration of the rejections is respectfully requested.

C. Claims 6, 13 and 22

The Office Action rejects claims 6, 13 and 22 under 35 U.S.C. §103(a) as allegedly being unpatentable over Nakamura in view of Dennis and further in view of U.S. Patent No. 5,717,607 to Vondran. This rejection is respectfully traversed.

Vondran would not remedy the deficiencies of Nakamura and Dennis discussed with regard to claims 1, 8 and 15. Claim 6 depends from claim 1, claim 13 depends from claim 8, and claim 22 depends from claim 15. Thus, for at least the reasons discussed with regard to independent claims 1, 8 and 15, claims 6, 13 and 22 would not have been rendered obvious by Nakamura in view of Dennis and further in view of Vondran. Accordingly, withdrawal and reconsideration of the rejection is respectfully requested.

D. Claims 7, 14 and 23

The Office Action rejects claims 7, 14 and 23 under 35 U.S.C. §103(a) as allegedly being unpatentable over Nakamura in view of Dennis and further in view of U.S. Patent No. 5,381,246 to Suzuki. This rejection is respectfully traversed.

Suzuki would not remedy the deficiencies of Nakamura and Dennis discussed with regard to claims 1, 8 and 15. Claim 7 depends from claim 1, claim 14 depends from claim 8 and claim 23 depends from claim 15. Thus, for at least the reasons discussed with regard to independent claims 1, 8 and 15, claims 7, 14 and 23 would not have been rendered obvious by Nakamura in view of Dennis and further in view of Suzuki. Accordingly, withdrawal and reconsideration of the rejection is respectfully requested.

V. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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